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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,341	03/22/2001	Nancy J. Bump	BBI-6069	4413

7590 06/26/2003

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EXAMINER	
SMITH, CAROLYN L	

ART UNIT	PAPER NUMBER
1631	17

DATE MAILED: 06/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/815,341	BUMP ET AL.	
	Examiner	Art Unit	
	Carolyn L Smith	1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 April 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-88* is/are pending in the application.

4a) Of the above claim(s) *1-20,28-31 and 34-88* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-27,32 and 33* is/are rejected.

7)☒ Claim(s) *21-24,26 and 27* is/are objected to.

8)☒ Claim(s) *1-88* are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *9* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: *See Continuation Sheet* .

Continuation of Attachment(s) 6). Other: Sequence Match Listing (3 pages).

DETAILED ACTION

Applicants' election with traverse of Group IV (claims 21-35) and specie election of Inhibitor III (on page 13 of the instant specification) in Paper No. 15, filed 4/15/03, is acknowledged. Claims 1-20 and 36-88 are withdrawn from consideration as being drawn to non-elected Groups. Claims 28-31, 34, and 35 are withdrawn from consideration as being drawn to non-elected species.

Applicants' traversal is on the grounds that the restriction groups are improper because requirements are not sufficiently met of (1) the invention must be independent and/or distinct as claimed and (2) there must be a serious burden placed on the Examiner by not requiring restriction.

Applicants' request to remove the restriction requirement was found unpersuasive because of the following reasons:

Although 35 USC 121 reads "If two or more independent *and* distinct inventions..." (italics added), it is noted that the Patent Office policy is to read this phrase as the following: "If two or more independent *or* distinct inventions..." (italics added). Therefore, the inventions must be independent or distinct, not necessarily both, to be suitable for restriction practice. Please refer to MPEP § 802.01 for further explanation of this issue.

Applicants' request to combine certain Groups is denied, because the Groups are patentably distinct. For instance, the structure of a crystalline polypeptide (Group I) contains distinct features not present in the crystalline polypeptide-ligand complex (Group II) and vice versa, including added interaction features present only in Group II, which make these Groups

patentably distinct. Groups I-V and X are directed to crystalline forms whereas the Group VI-IX are directed to natural forms of a Tie-2 inhibitor. These Groupings are further deemed patentably distinct between Groups due to their relatedness as products and processes of use. Please see previous Restriction Paper (pages 6-7) for detailed explanations of their distinctness.

Since these usages are distinct and contain non-overlapping search material, a search burden would be undue if they were all searched together.

The requirements are still deemed proper and are therefore made FINAL.

Claims herein under examination are 21-27, 32, and 33.

Specification

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code, such as on page 23, line 14, and elsewhere. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

The specification is objected to because of the following minor informality: "anaology" is misspelled on page 14, line 28. Correction of this and any other spelling or grammatical errors is requested.

Claim Objections

Claims 21-24, 26, and 27 are objected to because of the following minor informalities:

Claim 21, line 2, contains an extra space between "comprising" and "the".

Claim 21, line 2, and claim 22, line 1, are missing a colon after the phrase "the step(s) of".

Claim 21, line 6, contains the word "subsite" in singular form instead of proper plural form.

Claim 21, line 7, contains the word "bind" in plural form instead of proper singular form.

Claims 23-24, 26, and 27 are missing commas before the word "wherein".

Appropriate correction is requested.

Claim Rejections – 35 U.S.C. 112, first paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Factors to be considered in determining whether a disclosure would require undue experimentation have been summarized in *Ex parte Forman*, 230 USPQ 546 (BPAI 1986) and reiterated by the Court of Appeals in *In re Wands*, 8 USPQ2d 1400 at 1404 (CAFC 1988). The factors to be considered in determining whether undue experimentation is required include: (1) the quantity of experimentation necessary, (2) the amount or direction presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. The Board also stated that although the level of the skill in molecular biology is high, the results of experiments in genetic engineering are unpredictable. While all of these factors are considered, a sufficient amount for a *prima facie* case are discussed below.

LACK OF SCOPE OF ENABLEMENT

Claims 21-27, 32, and 33 are rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for the atomic coordinates for residues 802-1124 of Tie-2 and Inhibitor III complex, does not reasonably provide enablement for the atomic coordinates of an

unbound version of a Tie-2 polypeptide or atomic coordinates of the complete polypeptide of Tie-2 and Inhibitor III complex. The invention as presently stated in the claim 21 encompasses these additional sets of atomic coordinates, but they are not included in the specification which consequently causes a lack of scope of enablement of the instant invention for one of ordinary skill in the art.

The specification states that Tie-2 may be present in various states, such as single or multiple-phosphorylated species. Although Applicants have disclosed information to enable one skilled in the art to make a diphosphorylated Tie-2 protein crystal of the space group $P2_12_12_1$ with unit cell dimensions a = 54.320 Å, b = 75.872 Å, c = 78.143 Å, and $\alpha = \beta = \gamma = 90.0°$ (page 10, lines 14-25 and page 48, lines 11-19), a catalytically inactive mutant of human Tie-2/inhibitor crystal of a space group $C222_1$ with unit cell dimensions a = 75.195 Å, b = 116.287 Å, c = 95.060 Å, and $\alpha = \beta = \gamma = 90.0°$ (page 11, lines 1-2 and page 49, lines 24-25), and the crystal structures of three other crystals of Tie-2/ligand complexes, including a Tie-2/Inhibitor III complex, (page 11, line 3) of a space group P42212 with unit cell dimensions a = b = 86.0 Å, c = 112.0 Å, and $\alpha = \beta = \gamma = 90.0°$ (page 49, lines 26-28), the specification does not reasonably provide enablement for finding atomic coordinates of an unbound Tie-2 polypeptide as well as an entire Tie-2 polypeptide and Inhibitor III complex as encompassed in claim 21. The claim is broader than the enablement provided by the disclosure with regard to the atomic coordinate sets that could be used in the instant method claims. A method that relies on data from an unpredictable art such as protein crystallization would require clear and precise guidance for one skilled in the art to reliably use the said method. As the science of protein crystallization is well known to be a trial and error procedure with unpredictable results (Drenth, page 1, lines 13-20),

one skilled in the art would require clear and precise guidance to make any particular crystal in order to obtain atomic coordinates to define active subsites. Accordingly, it would be very difficult for one of ordinary skill in the art to obtain atomic coordinates beyond those mentioned in the instant case where specific coordinates are disclosed. Due to the unpredictability and difficulty of crystallizing proteins, it is unlikely that one of skill in the art would be able to make another crystal relying solely on the information for the crystal disclosed in the specification without undue experimentation. Again, due to the unpredictability in the art, one of skill in the art could not reasonably expect to obtain the structural coordinates of an unbound Tie-2 protein or a complete Tie-2 polypeptide/Inhibitor III complex based on generic guidelines of making crystals without undue experimentation.

LACK OF WRITTEN DESCRIPTION

Claims 21-27, 32, and 33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time of the invention was filed, had possession of the claimed invention.

Claims 21-27, 32, and 33 are directed to a method involving atomic coordinates of crystalline Tie-2 proteins and a Tie-2/Inhibitor III. Crystals structure data are provided for a diphosphorylated Tie-2 protein crystal of the space group $P2_12_12_1$ with unit cell dimensions a = 54.320 Å, b = 75.872 Å, c = 78.143 Å, and $\alpha = \beta = \gamma = 90.0°$ (page 10, lines 14-25 and page 48, lines 11-19), a catalytically inactive mutant of human Tie-2/inhibitor crystal of a space group $C222_1$ with unit cell dimensions a = 75.195 Å, b = 116.287 Å, c = 95.060 Å, and $\alpha = \beta = \gamma =$

90.0° (page 11, lines 1-2 and page 49, lines 24-25), and the crystal structures of three other crystals of Tie-2/ligand complexes, including a Tie-2/inhibitor III complex, (page 11, line 3) of a space group P42212 with unit cell dimensions a = b = 86.0 Å, c = 112.0 Å, and $\alpha = \beta = \gamma = 90.0°$ (page 49, lines 26-28). Atomic coordinates are provided in Fig. 5A-5RR for the catalytic domain of Tie-2 (residues 802-1124) and inhibitor III complex (page 5, lines 5-15); however, atomic coordinates are not provided for the unbound Tie-2 polypeptide or for the entire Tie-2 polypeptide and inhibitor III complex which are encompassed in the "comprising" language used on line 3 of claim 21. Applicants have not sufficiently described these additional sets of atomic coordinates which can be used in the claimed methods in such full, clear, concise terms that an artisan of ordinary skill in the art would recognize Applicants were in possession of the claimed invention.

The specification discloses SEQ ID NO: 1 which corresponds to amino acid sequence of a Tie-2 protein. SEQ ID NO: 1 meets the written description provisions of 35 U.S.C. 112, first paragraph. Also, claim 27 gives sequence written basis for amino acid residues 802-1124. However, due to the open claim language of "comprises" in claim 27, this claim is directed to encompass amino acid sequences that do not meet the written description provision of 35 U.S.C. 112, first paragraph. The specification provides insufficient written description to support the genus encompassed by this claim.

Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession *of the invention*. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed.*" (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See Vas-Cath at page 1116.)

With the exception of SEQ ID NO: 1, the skilled artisan cannot envision the detailed chemical structure of the encompassed polynucleotides and/or proteins, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it. The nucleic acid itself is required. See Fiers v. Revel, 25 USPQ2d 1601, 1606 (CAFC 1993) and Amgen Inc. V. Chugai Pharmacentical Co. Ltd., 18 USPQ2d 1016. In Fiddes v. Baird, 30 USPQ2d 1481, 1483, claims directed to mammalian FGF's were found unpatentable due to lack of written description for the broad class. The specification provided only the bovine sequence.

Finally, University of California v. Eli Lilly and Co., 43 USPQ2d 1398, 1404, 1405 held that:

...To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." *Lockwood v. American Airlines, Inc.* , 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); *In re Gosteli* , 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (" [T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Lockwood* , 107 F.3d at 1572, 41 USPQ2d at 1966.

Therefore, only SEQ ID NO: 1, residues 802-1124 of SEQ ID NO: 1, and atomic coordinates found in Fig. 5A-5RR, but not the full breadth of the claims, meet the written description provision of 35 USC 112, first paragraph. The species specifically disclosed are not representative of the genus because the genus is highly variant. Applicant is reminded that Vas-Cath makes clear that the written description provision of 35 USC 112 is severable from its enablement provision. (See page 1115.)

Claims Rejected Under 35 U.S.C. § 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-27, 32, and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Claims 21-25 are vague and indefinite due to the unclarity of citing an abbreviation, such as Tie-2. Correction is suggested by amending in of the full name in parentheses. Claims 26-27, 32, and 33 are also rejected due to their direct or indirect dependence from claims 21 and 24.

Claim 32 recites the limitation "the ligand" in line 1. There is insufficient antecedent basis for this limitation in the claim or in the claims from which it is dependent. Correction of this insufficiency is required so that proper antecedent basis is present. Claim 33 is also rejected due to its dependency from claim 32.

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. (e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 21, 22, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (P/N 6,160,092), in view of *In re Gulack* (703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983)).

Chen et al. describe a method for identifying an agent that diminishes the activity of a protein (col. 4, lines 56-60). Chen et al. describe determining the three-dimensional structure of a compound based on structural coordinates obtained from X-ray crystallographic analysis of crystals (col. 4, lines 14-22). Chen et al. describe various binding domains of a protein (col. 6, lines 12-18 and col. 9, lines 56-64), interactive areas in these domains using crystal structure data (col. 10, lines 3-9) and catalytic sites (col. 14, lines 61-65). Chen et al. describe using computer modeling to select potential agents and contacting the agents with the protein (col. 4, col. 21-26). Chen et al. describe determining whether the agent affects the ability of the protein to induce expression of a gene that is operably under the control of a promoter containing the binding site for the protein (col. 4, lines 56-50). Chen et al. describe the potential modulator can be synthesized de novo or selected from a library of chemicals (col. 23, lines 13-24). Chen et al. describe that the proteins and core fragments thereof may be chemically synthesized (col. 19, lines 21-24) and modified (col. 5, lines 38-39). Chen et al. describe identifying potential modulators by screening a random peptide library and further modified using computer modeling programs (col. 22, lines 51-59). Even though the method described by Chen et al. does not specify that the active site was identified by the crystal structure coordinates and the three-dimensional model of the Tie-2 protein and Tie-2/Inhibitor III complex, the specific limitations

of crystal structure coordinates and the three-dimensional model of the Tie-2 protein and Tie-2/Inhibitor III complex in this instant case do not distinguish the invention from the prior art in terms of patentability, because they are nonfunctional descriptive subject matter.

In re Gulack defines nonfunctional descriptive material to be descriptive material that is not functionally related to the substrate, in such a way that this descriptive material will not distinguish the invention from the prior art in terms of patentability. Also, the MPEP indicates that descriptive material unable to exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition (MPEP § 2106, section VI). Due to the fact that the coordinate data set derived from the crystal structure of the Tie-2 protein or Tie-2/Inhibitor III complex to develop three-dimensional models in the instant case are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, this descriptive material alone does not impart functionality either to the data as structured, or to the computer. As the invention of Chen et al. contains a method for identifying agents that interact with a protein and various modifications to their invention would be apparent to one of ordinary skill in the art (col. 38, lines 2-5), an artisan of ordinary skill in the art would have been motivated to include any crystalline protein already identified into this method in order to search for new drugs (col. 3, lines 5-9). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the three-dimensional model of the Tie-2 protein and Tie-2/Inhibitor III in the method, in order to search for possible drug candidates, as

described by Chen et al. (col. 4, lines 32-38). Thus, Chen et al., in view of *In re Gulack*, motivate claims 21, 22, and 26.

Claims 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (P/N 6,160,092), in view of *In re Gulack* (703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983)), *In re Best* (195 USPQ 430) and *In re Fitzgerald* (205 USPQ 594), and Ziegler (P/N 5,447,860).

Chen et al. describe a method for identifying an agent that diminishes the activity of a protein (col. 4, lines 56-60). Chen et al. describe determining the three-dimensional structure of a compound based on structural coordinates obtained from X-ray crystallographic analysis of crystals (col. 4, lines 14-22). Chen et al. describe various binding domains of a protein (col. 6, lines 12-18 and col. 9, lines 56-64), interactive areas in these domains using crystal structure data (col. 10, lines 3-9) and catalytic sites (col. 14, lines 61-65). Chen et al. describe using computer modeling to select potential agents and contacting the agents with the protein (col. 4, col. 21-26). Chen et al. describe determining whether the agent affects the ability of the protein to induce expression of a gene that is operably under the control of a promoter containing the binding site for the protein (col. 4, lines 56-50). Chen et al. describe the potential modulator can be synthesized de novo or selected from a library of chemicals (col. 23, lines 13-24). Chen et al. describe that the proteins and core fragments thereof may be chemically synthesized (col. 19, lines 21-24) and modified (col. 5, lines 38-39). Chen et al. describe identifying potential modulators by screening a random peptide library and further modified using computer modeling programs (col. 22, lines 51-59). Chen et al. do not describe the three-dimensional structure of

the Tie-2 or Tie-2/Inhibitor III complex, various characteristics of the Tie-2 protein, or the amino acid sequence of SEQ ID NO: 1.

Even though the method described by Chen et al. does not specify that the active site was identified by the crystal structure coordinates and the three-dimensional model of the Tie-2 protein and Tie-2/Inhibitor III complex, the specific limitations of crystal structure coordinates and the three-dimensional model of the Tie-2 protein and Tie-2/Inhibitor III complex in this instant case do not distinguish the invention from the prior art in terms of patentability, because they are nonfunctional descriptive subject matter.

In re Gulack defines nonfunctional descriptive material to be descriptive material that is not functionally related to the substrate, in such a way that this descriptive material will not distinguish the invention from the prior art in terms of patentability. Also, the MPEP indicates that descriptive material unable to exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition (MPEP § 2106, section VI). Due to the fact that the coordinate data set derived from the crystal structure of the Tie-2 protein or Tie-2/Inhibitor III complex to develop three-dimensional models in the instant case are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, this descriptive material alone does not impart functionality either to the data as structured, or to the computer.

Ziegler describes a polypeptide sequence of a receptor tyrosine kinase (Fig 1f-1h, residues 802-1124) that is identical to residues 802-1124 of SEQ ID NO: 1 of the instant invention (see Sequence Match Listing) as stated in claim 27. Ziegler describes this amino acid

sequence is from human cDNA (col. 4, lines 25-27) and can be found in mammalian sources (col. 6, line 41) as stated in claims 23 and 24. Ziegler describes a native, or wild-type, human ork protein (col. 5, lines 62-65). [It is interesting to note that Ziegler states ork and Tie proteins are distinctly different as presented in Figures 5a and 5b (col. 5, lines 15-26); however, the entire sequence in the instant invention shows that Tie-2 completely matches the ork sequence described by Ziegler.] Ziegler describes that ork can be used as a research tool for identifying ligands and assessing the biological effects of ligand binding (col. 17, lines 26-55) as stated in claim 22.

Since the sequences of ork (as stated by Ziegler) and Tie-2 (as stated in the instant invention) appear to be identical, *In re Best* (195 USPQ 430) and *In re Fitzgerald* (205 USPQ 594) are hereby enforced.

It is noted that *In re Best* (195 USPQ 430) and *In re Fitzgerald* (205 USPQ 594) discuss the support of rejections wherein the prior art discloses subject matter which there is reason to believe inherently includes functions that are newly cited or is identical to a product instantly claimed. In such a situation the burden is shifted to the applicants to "prove that subject matter shown to be in the prior art does not possess characteristic relied on" (205 USPQ 594, second paragraph, first full paragraph).

As the invention of Chen et al. contains a method for identifying agents that interact with a protein and various modifications to their invention would be apparent to one of ordinary skill in the art(col. 38, lines 2-5), a person of ordinary skill in the art would have been motivated to include any crystalline protein already identified into this method in order to search for new drugs (col. 3, lines 5-9). Therefore, it would have been obvious to one having ordinary skill in

the art at the time the invention was made to include the three-dimensional model of the Tie-2 protein (which has the inherent characteristics as presented by Ziegler) and Tie-2/Inhibitor III in the method, in order to search for possible drug candidates, as described by Chen et al. (col. 4, lines 32-38). Thus, Chen et al., in view of *In re Gulack, In re Best, In re Fitzgerald*, and Ziegler, motivate claims 21-27 in the instant invention.

Claims 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (P/N 6,160,092), in view of Vikkula et al. (Cell, 1996, Volume 87, pages 1181-1190) and *In re Best* (195 USPQ 430) and *In re Fitzgerald* (205 USPQ 594).

Chen et al. describe a method for identifying an agent that diminishes the activity of a protein (col. 4, lines 56-60). Chen et al. describe determining the three-dimensional structure of a compound based on structural coordinates obtained from X-ray crystallographic analysis of crystals (col. 4, lines 14-22). Chen et al. describe various binding domains of a protein (col. 6, lines 12-18 and col. 9, lines 56-64), interactive areas in these domains using crystal structure data (col. 10, lines 3-9) and catalytic sites (col. 14, lines 61-65). Chen et al. describe using computer modeling to select potential agents and contacting the agents with the protein (col. 4, col. 21-26). Chen et al. describe determining whether the agent affects the ability of the protein to induce expression of a gene that is operably under the control of a promoter containing the binding site for the protein (col. 4, lines 56-50). Chen et al. describe the potential modulator can be synthesized de novo or selected from a library of chemicals (col. 23, lines 13-24). Chen et al. describe that the proteins and core fragments thereof may be chemically synthesized (col. 19, lines 21-24) and modified (col. 5, lines 38-39). Chen et al. describe identifying potential

modulators by screening a random peptide library and further modified using computer modeling programs (col. 22, lines 51-59). Chen et al. do not describe the three-dimensional structure of the Tie-2 or Tie-2/Inhibitor III complex.

Vikkula et al. describe a three-dimensional structure of a domain location of Tie-2 receptor kinase (Figure 6). Vikkula et al. describe a GenBank accession number L06139 (see GenBank reference with both nucleic acid and polypeptide translation) which is nucleic acid sequence of human Tie-2 protein (page 1183, col. 2, first paragraph) that is 100% identical to the residues 802-1124 of the sequence in the instant invention (see Sequence Match Listing of encoded protein match). Vikkula et al. describe using wild-type and mutant Tie-2 cDNA in their research (page 1183, col. 2, second paragraph to page 1184, col. 1, second paragraph) as stated in claims 23-25 and 27. Although Vikkula et al. do not describe the atomic coordinates obtained from a crystallized protein, as stated in claim 1 (lines 3-4), this limitation appears to be merely an additional measurement made of the same Tie-2 as described by Vikkula et al.

It is noted that *In re Best* (195 USPQ 430) and *In re Fitzgerald* (205 USPQ 594) discuss the support of rejections wherein the prior art discloses subject matter which there is reason to believe inherently includes functions that are newly cited or is identical to a product instantly claimed. In such a situation the burden is shifted to the applicants to "prove that subject matter shown to be in the prior art does not possess characteristic relied on" (205 USPQ 594, second paragraph, first full paragraph).

As the invention of Chen et al. contains a method for identifying agents that interact with a protein and various modifications to their invention would be apparent to an artisan of ordinary skill in the art (col. 38, lines 2-5), one of ordinary skill in the art would have been motivated to

include any crystalline protein complex already identified into this method in order to search for new modulators (col. 3, lines 5-9). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the three-dimensional model of the Tie-2 protein (as stated by Vikkula et al.) in the method, in order to search for possible drug candidates, as described by Chen et al. (col. 4, lines 32-38). Thus, Chen et al., in view of Vikkula et al. and *In re Best* (195 USPQ 430) and *In re Fitzgerald* (205 USPQ 594), motivate claims 21-27 in the instant invention.

Conclusion

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR §1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Smith, whose telephone number is (703) 308-6043. The examiner can normally be reached Monday through Friday from 8 A.M. to 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instruments Examiner Tina Plunkett whose telephone number is (703) 305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

June 16, 2003

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PRIMARY EXAMINER